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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/202,047 12/07/98 ITOH

K 20-4491F

EXAMINER

002292 HM12/0620  
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ART UNIT

PAPER NUMBER

1633

DATE MAILED:

06/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/202,047**

Applicant(s)  
**Kyogo Itoh, et al**

Examiner  
**Yvette Connell Albert**

Group Art Unit  
**1633**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-15 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1- 5 and 11, drawn to DNA encoding a protein, expression plasmid, and transformants, classified in class 435, subclass 320.1, 69.1, 325; and class 514, subclass 44.
  - II. Claims 6 - 9, and 12-13, drawn to tumor antigen protein/peptide, and medicine comprising protein, classified in class 530, subclasses 300 and 350; class 424, subclass 184.1; and class 514, subclass 2.
  - III. Claims 10, and 14-15, drawn to antibodies which bind specifically to tumor antigen peptide, classified in class 530, subclass 387.1 .

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the antigen proteins of invention II can be made by another materially different process such as chemical synthesis, or enzymatically, or isolated and purified from tumor cells endogenously expressing the antigen. The differences between the inventions are further underscored by their divergent classification and independent search status.

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Invention I is distinct from inventions II and III, because invention I drawn to the characterization of a DNA and its recombinant expression in host cells, is distinct from the polypeptides of invention II and the antibodies of invention III, in terms of chemical structure, function and therapeutic effect. In addition, polynucleotides, polypeptides, and antibodies can be used by materially different methods. Polynucleotides can be used as hybridization probes for screening cDNA and genomic libraries, polypeptides can be used for antigen presenting cell priming, while antibodies can be used in screening assays, for example. The differences between inventions I, II, and III, are further underscored by their divergent classification and independent search status.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent classification, recognized divergent subject matter, and further because the searches required for the different inventions are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. 1.821 (a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. 1.821-1.825 for the reason(s)

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set forth on the attached Notice To Comply With Requirements For Patent Applications  
Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

**A complete response to this Office action must include an election as per the  
restriction and compliance with the sequence rules.**

Any inquiry concerning this communication or earlier communications from the examiner  
should be directed to Yvette Connell, whose telephone number is 703-308-7942. The examiner  
can normally be reached on Monday-Friday from 8:00 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, John LeGuyader can be reached on 703-308-0447.

Any inquiry of a general nature or relating to the status of the application should be  
directed to the group receptionist whose telephone number is 703-308-0196. The fax number for  
the organization where this application or proceeding is assigned is 703-308-4242.

Yvette Connell

June 16, 2000



JOHN L. LeGUYADER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600